

REMARKS

Claims 1-48 are pending. In the March 28, 2005, Office Action, the Examiner objected to the specification because of informalities relating to the description and title, and required updating of the related applications information and a new title that is clearly indicative of the invention to which the claims are directed. In addition, the Examiner provisionally rejected claims 1, 15, and 29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, and 15, respectively, of co-pending application No. 10/034,748. Claims 1-7, 10-21, 24-35, 38-43, and 45-48 were also rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,615,235 to Copeland et al. (hereinafter “Copeland”). Finally, claims 8, 9, 22, 23, 36, 37 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Copeland in view of Publication No. 2002/0007393 to Hamel (hereinafter “Hamel”). Applicants respectfully traverse the rejections for the reasons set forth hereinbelow.

A. Amendments to Specification and Title

Applicants have corrected the description of the related applications to include updated information. In addition, Applicants have also revised the title as required by the Examiner, though Applicants submit that the original title was clearly descriptive of the invention to which the claims are directed.

B. Provisional Obviousness-Type Double Patenting Rejection

In the March 28, 2005 Office Action, the Examiner provisionally rejected pending claims 1, 15 and 29 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8 and 15, respectively of co-pending Application Serial No. 10/034,748, which was filed on the same day as the present application. Applicants respectfully traverse the provisional rejection and request that pending claims 1, 15 and 29 be allowed for the reasons set forth herein.

As a preliminary matter, Applicants respectfully submit that pending claims 1, 15 and 29 of the pending application are patentably distinct from claims 1, 8 and 15, respectively of co-pending Application Serial No. 10/034,748. In particular, the *co-pending* claims recite a single linking element in the message body (e.g., co-pending claim 1 recites that the message header “indicates that the message body includes a linking element to a next-level fragment”), while the

pending claims recite that an “expansion attribute” in linking element in the message body is used to generate a plurality of linking elements (e.g., pending claim 1 recites “in response to determining that the first linking element comprises an expansion attribute, generating a set of linking elements in accordance with at least one parameter associated with the expansion attribute”). This is readily shown by the fact that different art references were used to reject these claims in the two applications. In particular, the Examiner in this application has rejected claims 1, 15 and 29 over the Copeland (and Hamel) references, while in the co-pending Application Serial No. 10/034,748, the Examiner rejected claims 1, 8 and 15 over the U.S. Patent Publication No. 2002/0004813 to Agrawal et al. and U.S. Patent No. 6,427,187 to Malcolm. *See*, Office Action from co-pending Application Serial No. 10/034,748 (February 24, 2005) (attached as Exhibit A). If the claims were in fact patentably indistinct, then both sets of claims would presumably be rejected on the basis of the same art.

Applicants further submit that the requirements from the applicable patent examination guidelines have not been met here for the case where a non-statutory obviousness-type double patenting rejection over a co-pending application. In particular, in cases where an application is provisionally rejected for non-statutory obviousness-type double patenting over a co-pending application where both applications were filed on the same day, “the examiner should determine which application claims the base invention and which application claims the improvement (added limitations).” *See*, MPEP, Section 804(I)(B)(1) (8th ed. Rev. 5, Oct. 2006) (“If ‘provisional’ [nonstatutory obviousness-type double patenting] ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.”). Pursuant to the enumerated guidelines, Applicants respectfully request that the examiner withdraw the provisional rejection and permit this application to issue without need of a terminal disclaimer, or in the alternative provide an indication of “which

application claims the base invention and which application claims the improvement (added limitations)” so that Applicants can formulate an additional response.

Based on the present record, Applicants respectfully submit that the claims of the pending application are patentably distinct from the claims of co-pending Application Serial No. 10/034,748 so that neither application should be considered a “base invention” on which the other application is merely an improvement with additional limitations. However, even if the two applications did claim patentably indistinct subject matter (which they do not), the policy behind the nonstatutory double patenting rejections (namely, preventing prolongation of the patent term) does not appear to apply to the current situation where both applications were filed on the same day and therefore would have the same patent term.

C. Claims 1-7, 10-21, 24-35, 38-43, and 45-48 Are Not Anticipated by Copeland

In response to the Examiner’s rejection of claims 1-7, 10-21, 24-35, 38-43, and 45-48 as being anticipated by Copeland, Applicants respectfully request reconsideration and withdrawal of the rejection because Copeland’s disclosure of a scheme for coordinating caches does not anticipate the present invention’s scheme for including an expansion attribute (described in the specification as the FOREACH attribute) in a message fragment link which is used to automatically generate a set of multiple links to multiple fragments. *See, e.g.*, Application, paragraphs 111-112. This scheme is variously recited in the claims with reference to using the “expansion attribute” in a first linking element to identify multiple linking elements. *See, e.g.*, claims 1, 14, 15, 28, 29, 42 and 43.

Applicants respectfully submit that the claim rejections completely ignore the specific language of the claims that recite using an expansion attribute in a single link to generate multiple links. For example, the rejection of claim 1 states that this feature is found in Copeland at column 10, lines 43-63. *See, Office Action*, p. 4 (March 28, 2005).¹ However, a careful reading of the cited passage confirms that Copeland is not disclosing the present invention’s use of a single fragment link to efficiently generate multiple links to multiple fragments. In particular, Copeland suggests that a fragment that contains child links can be stored in the cache

¹ The Examiner cites the same passage (Copeland, col. 10, lines 43-64) to meet the “expansion attribute” requirement of the remaining independent claims 14, 15, 28, 29, 42 and 43. *See, Office Action*, p. 7 (claims 14, 15, 28, 29 and 42) and p. 8 (claim 43).

in one of two forms: (1) by storing the fragment with each child fragment fully expanded, or (2) by storing the fragment with a link to each child fragment. Copeland, col. 10, lines 43-56.

Neither of the approaches suggested by Copeland uses an “expansion attribute” in the message fragment link to generate multiple links to multiple fragments, as variously recited in the claims. At best, Copeland discloses including a fragment link for each child fragment – in effect, multiple links to multiple fragments. With the present invention, the multi-linking feature is provided by including an expansion attribute (e.g., the FOREACH attribute described in the application) to expand a single fragment link into a set of multiple links to multiple fragments. Because Copeland does not disclose the multi-linking feature as claimed, Copeland cannot be used as an anticipatory reference against the claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). Accordingly, Applicants respectfully request that the anticipation rejection of claims 1-7, 10-21, 24-35, 38-43, and 45-48 be withdrawn and that the claims be allowed.

D. Claims 8, 9, 22, 23, 36, 37 and 44 Are Not Obvious Over Copeland In View of Hamel

In response to the Examiner’s rejection of claims 8, 9, 22, 23, 36, 37 and 44 as being obvious over Copeland in view of Hamel, Applicants respectfully request reconsideration and withdrawal of the rejection, not only for the noted deficiencies in the Copeland disclosure noted above, but also because the Copeland reference is disqualified as prior art against the claimed invention pursuant to 35 USC § 103(c). In particular, MPEP § 706.02(I)(1) states that “Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) was disqualified as prior art against the claimed invention if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.’”

Pursuant to MPEP § 706.02(I)(2), Applicants’ undersigned attorney of record hereby establishes common ownership of the Copeland reference and the present application by stating that the present application and the Copeland reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person, namely International Business Machines Corporation. With this statement, Applicants respectfully submit that the

Copeland reference is disqualified as prior art under 35 USC § 103, and request that the obviousness rejection of claims 8, 9, 22, 23, 36, 37 and 44 be withdrawn and that the claims be allowed.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

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Respectfully submitted,

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